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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/734,792 | 12/12/2003 | Erwin Hacker | 514413-3869.1 | 3467 |
| 20999 | 7590 | 03/14/2006 | EXAMINER | |
| FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | CLARDY, S | |
| | | | ART UNIT | PAPER NUMBER |

1617

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,792

Applicant(s)

HACKER ET AL.

Examiner

S. Mark Clardy

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4,6-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4,6-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/734,792.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/12/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 2-4, 6-9, and 11-13 are pending in this application which is a continuation of application 09/787,214, now abandoned, which was filed under 35 USC 371 as a national stage application of PCT/EP99/06937, filed September 20, 1999.

It is noted that the new claim 11 bears no resemblance to the previous claim 11, filed July 25, 2002, in the parent application, and drawn to the elected species, identified below.

Applicants' claims are drawn to herbicidal compositions comprising:

- A. An aminotriazinyl herbicide
- B. A second herbicidal component (see seven page list in new claim 11).

In the response filed July 25, 2002, applicants elected the composition comprising the following herbicides:

A2. N-(1-cyclopropyl-4-phenylbutyl)-6-(1-fluoro-1-methylethyl)-1,3,5-triazine-2,4-diamine

B1.3.3 Fenoxaprop.

This election will be maintained herein. No claims are now drawn specifically to the elected species, nor to the subject matter which was previously indicated as being commensurate in scope with other species for which data has been presented (and therefore allowable), i.e., the "A" group herbicides of formula X, in combination with sulfonylurea herbicides (see examples 1-22).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is dependent upon itself; claim 13 recites the halogen "biomine".

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6-9, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Giencke et al (US 6,239,071), Hoechst (PCT WO 98/34925), Hirata et al (A: EP 0 467 204; B: EP 0 469 406; C: EP 0 471 221; D: EP 0 471 284), Takematsu (Abstract of JPO Publication 04095003), Idemitsu (A: Abstract of JP 7267804; B: abstract of JP 7267805),

First it is noted that applicants have stated on the record that the aminotriazinyl herbicides herein are known and that they have been described in the prior art (specification, p. 27).

Giencke et al teach that aminotriazine herbicides may be combined with a large number of secondary herbicides (columns 18-20).

Hoechst teaches also that aminotriazine herbicides may be combined with various other herbicides (p. 36-38).

Hirata et al (A) teach the synergistic combination of aminotriazine herbicides with urea herbicides.

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Hirata et al (B) teach the synergistic combination of aminotriazine herbicides with benzoic acid or pyridine carboxylic acid herbicides.

Hirata et al (C) teach the synergistic combination of aminotriazine herbicides with thiocarbamate herbicides (formula II).

Hirata et al (D) teach the synergistic combination of aminotriazine herbicides with sulfonyleurea herbicides.

Takematsu teaches the combination of aminotriazine herbicides with dinitroaniline herbicides for selective weed control.

Idemitsu (A) teaches the synergistic combination of aminotriazine herbicides with prodiamine, dithiopyr, halosulfuron, triclopyr, napropamid, bensulide, propyzamide, flazasulfuron, imazosulfuron, and imazaquin.

Idemitsu (B) teaches the synergistic combination of aminotriazine herbicides with pyrazosulfuron-ethyl, MCPP, pendimethalin, besulodine, and simazine.

One of ordinary skill in the art would be motivated to combine these references because they teach the herbicidal utility of aminotriazine compounds in combination with a variety of secondary herbicides.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined applicants' aminotriazine herbicides with a second herbicidal agent, to make a synergistic herbicidal composition because a wide variety of such combinations has been shown by the cited prior art to result in synergistic compositions. Further, it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used

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for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069. Determination of appropriate concentration ranges would have been within the skill level of the ordinary artisan.

Applicants' data is sufficient to support a finding of nonobviousness for the elected species and for combinations wherein the A component is a herbicide of formula X, as in claim 3, in combination with sulfonylureas. The data, however, is incommensurate in scope with the remainder of the claims. Merely amending the claims to "proviso out" the specific combinations discussed in the cited prior art does not negate the teaching that it was known to combine the subject herbicidal compounds with any known herbicide. Further, in view of the teachings concerning synergy, it would appear that merely demonstrating synergistic results, as taught in the prior art, would be insufficient for overcoming the rejection.

No claim is allowed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

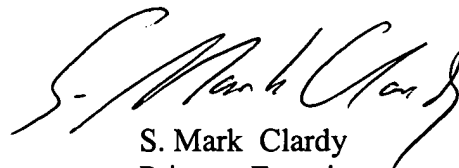
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is 571-272-0611. The examiner can normally be reached on 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "S. Mark Clardy", is positioned above the printed name and title.

S. Mark Clardy
Primary Examiner
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March 10, 2006